



Docket No. 62171-00048USPT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
Robert H. Dueck et al. )  
Serial No.: 09/724,770 ) Examiner: C. Kao  
Confirmation No.: 7641 )  
Filed: November 28, 2000 ) Group Art Unit: 2882

For: A THERMALIZATION AND PRESSURE DESENSITIZATION OF  
DIFFRACTION GRATING BASED WDM DEVICES

TERMINAL DISCLAIMER  
DISAPPROVED

MAY 13 2003

TECHNOLOGY CENTER 2800  
SPECIAL PROGRAM CENTER

BOX: FEE AMENDMENT  
Commissioner for Patents  
Washington, D.C. 20231

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited postage paid  
with the United States Postal Service as first class mail in an envelope  
addressed to: Commissioner for Patents, Washington, D.C. 20231

on: April 21, 2003

*Carol Mitchell*  
Signature Carol Mitchell

Dear Sir:

TERMINAL DISCLAIMER

Petitioners, Robert H. Dueck and Gregory G. Cappiello, are the owners of the entire right, title and interest in and to the invention claimed and disclosed in the above-captioned patent application.

The petitioners hereby disclaims the terminal part of the statutory term of any patent granted on the above-captioned application, which would extend beyond the expiration date of the full statutory term as presently shortened by any terminal disclaimer of prior U.S. Application Serial No. 09/724,711, and hereby agrees that any patent so granted on said above-captioned application shall be enforceable only for and during such period that it and the prior application are commonly owned. This agreement runs with any patent granted on the above-captioned application and to be binding

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upon the grantee, its successors or assigns.

The Petitioner does not disclaim any terminal part of any patent granted on the above-captioned application that would extend to the expiration date of the full statutory term of the prior application, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. 1.321, has all claims canceled by a reexamination certificate, is reissued, or is otherwise terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer, except for the separation of legal title stated above.

The undersigned is an attorney of record.

RENEE PRESTON *R. Preston*  
PARALEGAL SPECIALIST  
TECHNOLOGY CENTER 2800

TERMINAL DISCLAIMER  
DISAPPROVED  
MAY 13 2003  
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Respectfully submitted,

JENKENS & GILCHRIST,  
A Professional Corporation

*Joshua A. Griswold*  
Joshua A. Griswold  
Reg. No. 46,310

Jenkins & Gilchrist  
A Professional Corporation  
1445 Ross Avenue  
Suite 3200  
Dallas, TX 75202-2799  
(214) 855-4237  
(214) 855-4300 (fax)

## T.D. INFORMAL MEMO: DO NOT MAIL THIS MEMO TO APPLICANT

DATE: 13-May-03APPL. S.N.: 09/724,770TO: EXAMINER Kao Chin-ChenART UNIT: 2882FROM: Preston, Renee

PARALEGAL SPECIALIST

RETURN THIS MEMO TO: **CP4-6D34**SUBJECT: Decision on Terminal Disclaimer (T.D.) filed: 28-Apr-03

INSTRUCTIONS: I have reviewed the submitted T.D. with the results as set forth below. If you agree, please use the appropriate form paragraphs identified by this informal memo in your next Office action to notify applicant of the T.D. If you disagree or have any questions, please see me or the Special Program Examiner. THIS IS AN INFORMAL, INTERNAL MEMO ONLY. IT MUST NOT BE (1) MAILED TO APPLICANT OR (2) PLACED OF RECORD IN THE APPLICATION FILE. When your action is complete, please initial, date and return this memo to me. THANK YOU.

☐ The T.D. is PROPER and has been recorded (see ¶ 14.23).

☒ The T.D. is NOT PROPER and has not been accepted for the reason(s) checked below (see ¶ 14.24):

☐ The TD fee of \_\_\_\_\_ has not been submitted nor is there any authorization in the application file for the use of a deposit account (see ¶ 14.26.07).

☐ The T.D. does not satisfy Rule 321 in that the person who has signed the T.D. has not stated the extent of his/her interest (and/or the extent of the interest of the business entity represented by the signature) in the application patent (see ¶¶ 14.26 & 14.26.01).

☐ The T.D. lacks the enforceable only during common ownership clause needed to overcome a non-statutory double patenting rejection. Rule 321(b) (see ¶ 14.27.01).

☐ The T.D. is directed to a particular claim(s), which is not acceptable since "the disclaimer must be for a terminal portion of the term of the entire patent to be granted" (MPEP 1490) (see ¶¶ 14.26 & 14.26.02).

☐ The person who signed the T.D.:

☐ is not an attorney "of record" (see ¶¶ 14.29 and 14.29.01).

☐ has failed to state his/her capacity to sign for the business entity (see ¶ 14.28).

☐ is not recognized as an officer of the assignee (see ¶¶ 14.29 & possible 14.29.02).

☐ No documentary evidence of a chain of title from the original inventor(s) to assignee has been submitted, nor is the reel and frame number specified as to where such evidence is recorded in the Office (see 37 CFR 3.73(b) and 1140 O.G. 72). NOTE: This documentary evidence or the specifying of the reel and frame number may be found in the T.D. or in a separate paper of record in the application (see ¶ 14.30).

☐ The T.D. is not signed (see ¶¶ 14.26 & 14.26.03).

☒ The serial number of the application (or the number of the patent) which forms the basis for the double patenting rejection is missing or incorrect (see ¶ 14.32).

☐ The serial number of this application (or the number of the patent in reexam or reissue cases being disclaimed is missing or incorrect (see ¶¶ 14.26, 14.27.02 or 14.26.05).

☐ The period disclaimed is incorrect or not specified (see ¶¶ 14.26, 14.27.02 or 14.26.03).

☒ Other: 09/724,711 should be 09/724,771.

☐ Suggestion to request refund (see ¶ 14.36). NOTE: If already authorized, credit refund to deposit account and **do not** check this item.

I have appropriately notified applicant(s) of the status of the Terminal Disclaimer filed in this case.

Ex Initials:

Date:

Log Date:

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(Rev. 5.98)

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Tuesday, May 13, 2003 7:04:40 PM